

The Office has required restriction in the present application as follows:

- Group I: Claims 1-17, drawn to compounds in formula (I) wherein R1 is as defined, R2 is carboxy, protected carboxy or amidated carboxy, Ar is optionally substituted aryl, A is lower alkylene, X is oxa, Y is thia, Z is methylene, and a composition, a process and a method of use;
- Group II: Claims 1-17, drawn to compounds in formula (I) wherein R1 is lower alkyl, R2 is carboxy, protected carboxy or amidated carboxy, Ar is optionally substituted aryl, A is lower alkylene, X is a single bond, Y is thia, Z is thia, and a composition, a process, and a method of use;
- Group III: Claims 1-17, drawn to compounds in formula (I) protected carboxy or amidated carboxy, Ar is optionally substituted aryl, A is lower alkylene, X is oxa, Y is thia, Z is sulfinyl, and a composition, a process, and a method of use; and
- Group IV: Claims 1-17, drawn to protected carboxy or amidated carboxy, Ar is optionally substituted aryl, A is lower alkylene, X is oxa, Y is thia, Z is sulfonyl, and compositions, a process, and a method of use; **-OR-**

An alternate group not listed above, which is exemplary of the invention (see paper number 7, page 3, lines 1-6).

Applicants elect, with traverse, the Group defined as:

Claims 1-17, drawn to compounds in formula (I) wherein

R1 is as defined, (namely, lower alkyl, halogen, optionally substituted
hererocyclic group or optionally substituted aryl)
R2 is as defined, (namely, carboxy, protected carboxy or amidated carboxy)
Ar is thienyl
A is ethylene or trimethylene
X is as defined, (namely, oxa or a single bond)
Y is as defined, (namely, thia, sulfinyl or sulfonyl)
Z is methylene, and
m and n are as defined.

The Office, citing PCT Rules 13.1 and 13.2, contends that the species lack unity of invention because they lack a significant structural element qualifying as the special technical feature.

The Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

Applicants submit that each of the alternatives share a common activity: metalloproteinase inhibition. In addition, each alternative has a common structure: formula (I). Accordingly, criteria (A) and (B)(1) are met and the alternatives are of a similar nature as that term is defined in Annex B above.

Applicants traverse that Restriction Requirement on the additional grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (see copy appended herewith). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(1) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.


Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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